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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,080	11/13/2001	Jerome P. Ranch	0881	6034
27310	7590	07/29/2004	EXAMINER	
PIONEER HI-BRED INTERNATIONAL INC. 7100 N.W. 62ND AVENUE P.O. BOX 1000 JOHNSTON, IA 50131			KALLIS, RUSSELL	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/993,080	RANCH ET AL.	
	Examiner	Art Unit	
	Russell Kallis	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 3,7-10,14-24,27,31-34,38-48,51 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2,4-6,11-13,25-26,28-30,35-37,49-50,52-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-62 are pending. Claims 1-2, 4-6, 11-13, 25-26, 28-30, 35-37, 49-50 and 52-61 are examined. Claims 3, 7-10, 14-24, 27, 31-34, 38-48, 51 and 62 are withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejection of Claims 4-5, 28-29, 54-57 and 61 under 35 U.S.C. 112, second paragraph, is withdrawn in view of Applicant's amendments.

Claim Rejections - 35 USC § 102

Claims 1-2, 4-6, 11-12, 25-26, 28-30, 35-36, 49-50, 52-54 and 58-60 remain rejected under 35 U.S.C. 102(b) as being anticipated by Dunder E. *et al.* in Maize Transformation by Microprojectile Bombardment of Immature Embryos; Springer-Verlag, Berlin-Heidelberg; pages 127-138. This rejection is maintained for the reasons of record set forth in the Official action mailed 2/04/2004. Applicant's arguments filed 5/04/2004 have been considered but are not deemed persuasive.

Applicant asserts the Dunder reference does not teach fresh embryo transformation because it has not enabled the stable transformation of freshly isolated embryos (response page 14, lines 1-7). Dunder anticipates fresh embryo transformation by providing guidance for placing immature embryos that are to be bombarded on the day of their isolation directly onto osmotic treatment plates. Dunder also successfully recovered transformants by bombarding freshly isolated immature maize embryos after a day of culturing and therefore enables transformation of freshly isolated embryos.

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Applicant further asserts that IDS references of Songstad (A5) and Brettschneider (A3) teach away from obtaining stably transformed plants by bombarding freshly isolated maize embryos (response page 14, lines 7-18). It is not clear how the Brettschneider reference can teach away since it teaches successful transformation of a freshly isolated maize embryo when both osmotic pretreatment and the biolistic bombardment were performed 1 day after isolation (i.e. within 24 hours) on page 742 in Table 4, the second entry. Further, if in fact Songstad used the same method claimed by Applicant, but did not yield transformants, Applicant has not distinguished their invention from what is taught in the prior art. Applicant should amend the claims to limit the scope to the teachings of unexpected results. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

Claims 1-2, 4-6, 11-12, 25-26, 28-30, 35-37, 49-50, 52-57 and 58-61 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dunder E. *et al.* in Maize Transformation by Microprojectile Bombardment of Immature Embryos; Springer-Verlag, Berlin-Heidelberg; pages 127-138. This rejection is maintained for the reasons of record set forth in the Official action mailed 2/04/2004. Applicant's arguments filed 5/04/2004 have been considered but are not deemed persuasive.

Applicant asserts that a reasonable expectation of success is not found in Dunder (response page 15, end of page). Dunder successfully transforms freshly isolated embryos as discussed supra.

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Russell Kallis Ph.D.
July 7, 2004



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SUPERVISORY PATENT EXAMINER
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